

REMARKS

In the Office Action dated August 25, 2006, the Examiner rejected claims 1-3, 7, 10-24, 28, 31-36, 38-45, 49, 52-57, and 59-63 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,196,458 to *Walker et al.* ("*Walker*"); and rejected claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58 under 35 U.S.C. § 103(a) as being unpatentable over *Walker* in view of U.S. Patent Publication No. 2003/0105682 to *Dicker et al.* ("*Dicker*").

By this Amendment, Applicants propose amending claims 1, 22, and 43, and adding new claims 64-69. Support for Applicants' claim amendments can be found, for example, in Applicants' specification on pages 7-8 and 10-14. By this Amendment, claims 1-69 would be pending in this application.

I. Rejection of Claims 1-3, 7, 10-24, 28, 31-36, 38-45, 49, 52-57, and 59-63 Under 35 U.S.C. § 102(e)

In order for *Walker* to anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim."

See M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). *Walker* fails to anticipate the claims because *Walker* does not disclose, expressly or otherwise, each and every feature recited in independent claims 1, 22, 43, and 68-69.

Claims 1, 22, and 43

Amended independent claim 1, recites, *inter alia*, “

creating a data structure to store the received purchasing data;
using a computer to identify, for each transaction, a product related
to the transaction by comparing the received purchasing data with product
information stored in a product index. . . [and]
modifying the received purchasing data in the data structure to
include data representing the identified product;

Walker is directed to determining whether billing items on an account
holder's billing statement satisfy any merchant-specified upsell offer conditions.
(*Walker*, Abstract.) If one or more of the conditions are met, an upsell is offered
to the account holder by printing the upsell onto the billing statement of the
account holder. (See *Id.*) *Walker* does not teach or suggest “creating a data
structure to store the received purchasing data; using a computer to identify, for
each transaction, a product related to the transaction. . . [and] modifying the
received purchasing data in the data structure to include data representing the
identified product,” as recited in claim 1.

The Examiner cites column 5, lines 32-39 of *Walker* for an alleged
teaching of the above-recited claim limitations. Applicants respectfully disagree.
The portions cited by the Examiner state that the *Walker* system receives and
stores billing items generated by transactions (e.g., purchases) on an account
holder's account. (See *Id.* at col. 5, ll. 32-34.) “If the billing items [satisfies] any
upsell offer conditions stored in the upsell database . . . and . . . if the billing
items [satisfies] an upsell offer condition, the system determines an upsell
corresponding to the upsell offer condition and prints on the billing statement

indicia that specifies the upsell.” (See *Id.* at ll. 35-39.) The account holder transaction database stores information related to transactions by the account holder, and this information is used to determine whether an account holder should be offered an upsell. (See *Id.* at col. 6, ll. 38-43.)

First, *Walker* does not teach or suggest “using a computer to identify, for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index,” as recited in claim 1, because the *Walker* system is “analyz[ing] the transactions” to determine if upsell offer conditions are met. At most, *Walker* is identifying an upsell product to offer an account holder based on the transactions on their account. This is accomplished by comparing the transaction to conditions such as “if any billing item indicates a purchase of a predefined product,” or “if any billing item indicates a purchase for more than a predefined price.” (See *Id.* at col. 7, ll. 35-38.) This comparison of the transactions to conditions and selecting an upsell product based on the comparison is not a teaching or suggestion of “idenfity[ing] for **each** transaction, a product related to the transaction by comparing the received purchasing data with **product information stored in a product index**,” as recited in claim 1.

Furthermore, *Walker* is storing all the account holder’s transaction information in a database, and modifying the billing statement of the account holder to notify them of the upsell. (See *Id.* at col. 5, ll. 39-40.) This is not a teaching or suggestion of “**creating a data structure to store the received purchasing data . . . and modifying the received purchasing data in the data**

structure to include data representing the identified product,” as recited in claim

1. In fact, in *Walker*, the transactions in the database related to an account holder appear to never be modified. The only modification is on the billing statement of the account holder, where an upsell product is identified. The billing statement, however, is not a teaching or suggestion of a “data structure to store the received purchasing data,” as recited in claim 1. Therefore, *Walker* fails to teach or suggest “creating a data structure to store the received purchasing data; using a computer to identify, for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index. . . [and] modifying the received purchasing data in the data structure to include data representing the identified product,” as recited in claim 1. Claims 22 and 43 recite similar limitations, and therefore, *Walker* fails to disclose each of the features of these claims for at least one reason similar to those discussed above for claim 1.

Claim 68

Independent claim 68, recites, *inter alia*, “receiving purchasing data from a purchasing entity, wherein the purchasing data relates to general ledger account information associated with purchase transactions made by the purchasing entity.” *Walker* does not teach or suggest this claim limitation because in the *Walker*, the system is collecting billing items generated by transactions (e.g., purchases) for an account holder. (See *Id.* at col. 5, ll. 30-33.) Transaction information may include a date of a transaction, a date when the transaction is posted, a transaction amount, a merchant identifier for specifying a merchant

participating in the transaction, an item identifier for specifying an item purchase and any description of the transaction. (See *Id.* at col. 6, ll. 27-36.) These transaction identifiers are not a teaching or suggestion of data that “relates to general ledger account information,” as recited in claim 68. Therefore, *Walker* fails to teach or suggest “receiving purchasing data from a purchasing entity, wherein the purchasing data relates to general ledger account information associated with purchase transactions made by the purchasing entity,” as recited in claim 68.

Claim 69

Independent claim 69 recites, “wherein the purchasing entity is a member of a purchasing group, and wherein the purchasing data includes aggregate purchasing data reflecting aggregate purchase transactions of the purchasing group.” *Walker* also does not teach or suggest any “purchasing group,” much less “wherein the purchasing entity is a member of a purchasing group, and wherein the purchasing data includes aggregate purchasing data reflecting aggregate purchase transactions of the purchasing group,” as recited in claim 69.

Applicant, therefore, respectfully requests the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of independent claims 1, 22, 43, and 68-69 as well as claims 2-3, 7, 10-21, 23-24, 28, 31-35, 38-42, 44-45, 49, 52-57, and 59-67 at least due to their dependence from claims 1, 22, 43, and 68-69, respectively.

II. Rejection of Claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58

Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58 under 35 U.S.C. § 103(a) as being unpatentable over *Walker* and *Dicker*.

Applicants submit that the Examiner cannot establish a prima facie case of obviousness because the cited references fail to teach or suggest each and every limitation of the claims. See M.P.E.P. § 2143.01. As discussed above, *Walker* fails to teach or suggest the subject matter of independent claims 1, 22, and 43, from which claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58 depend, respectively. The Examiner rejects claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58 as being obvious over *Walker* in view of *Dicker*, but *Dicker* does not cure the deficiencies of *Walker*.

The Examiner cites *Dicker* only for its teaching of a “product index include[ing] a weight value.” (Office Action, p. 8.) However, *Dicker* does not teach or suggest the claimed subject matter missing from *Walker*, namely, “creating a data structure to store the received purchasing data; using a computer to identify, for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index. . . [and] modifying the received purchasing data in the data structure to include data representing the identified product” as recited in claims 1, 22, and 43. Nor does the Examiner assert that *Walker* discloses such features.

Accordingly, *Walker* and *Dicker*, taken alone or in combination, do not teach or suggest each and every element of claims 1, 22, and 43 and, therefore, cannot support a rejection of these claims or claims 4-6, 8-9, 16, 25-27, 29-30, 37, 46-48, 50-51, and 58, due to their dependence from claims 1, 22, and 43 under 35 U.S.C. § 103(a). Accordingly, reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: _____



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